UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,720	09/30/2004	Fred Bishop	60655.3917	5719

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EXAMINER
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ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
01/07/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2009*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5,6 and 9-11* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3, 5, 6, and 9-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination under 37 C.F.R. §1.114

1.   A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee

set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in

37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been

withdrawn pursuant to 37 C.F.R. §1.114. Applicants' submission filed on 10 September 2009

has been entered.

Acknowledgements

2.   This action is in reply to the amendments to the claims and remarks filed on 10

September 2009 ("09 Sept Response").

3.   Claims 1, 3, 5, 6, and 9-11 are currently pending and have been examined.

4.   This Office Action is given Paper No. 20091230. This Paper No. is for reference

purposes only.

Claim Rejections - 35 USC §103

5.   The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious at
> the time the invention was made to a person having ordinary skill in the art to which said subject
> matter pertains. Patentability shall not be negatived by the manner in which the invention was
> made.

6.   Claims 1, 3, 5, 6, and 9-11are rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor (U.S. 5,578,808 A), in view of Russell et al. (U.S. 2004/0044627 A1) ("Russell"), and in further view of Fisher (U.S. 2002/0040438 A1).

Regarding Claims 1 and 9

7.   Taylor discloses:

adding, to a first database on a transaction device, a first data set of a first format and a second data set of a second format (*e.g.*, "AMEX" and "VISA"), wherein: the first data set is owned by a first data set owner and the second data set is owned by a second data set owner, the first data set owner is distinct from the second data set owner, the first format is different from the second format, and the first data set is stored in accordance with the first format, and the second data set is stored in accordance with the second format; configuring a first method of authentication corresponding to the first data set and a second method of authentication corresponding to the second data set (distinct access codes for each vendor or issuer), wherein the first method of authentication and the second method of authentication are configured by the first data set owner and the second data set owner independently (each vendor sets access code); wherein, after authentication of the first data set owner using the respective method of authentication defined by the first data set owner, the first data set owner is provided access rights to the first data set, at least one access right including authorization to at least one of add and remove a static field of the first format, and wherein, after authentication of the second data set owner using the respective method of authentication defined by the second data set owner, the second data set owner is provided access rights to the second data set, at least one access

right including authorization to at least one of add and remove a static field of the second format;

receiving a selection of at least one of the first data set and the second data set to complete a

transaction request, wherein: if the first data set is selected, the receiving includes receiving a

first secondary identifier indicium corresponding to the first method of authentication, and if the

second data set is selected, the receiving includes receiving a second secondary identifier

indicium corresponding to the second method of authentication; authenticating, after receiving

the selection, the transaction request using the first secondary identifier indicium if the first data

set is selected and using the second secondary identifier indicium if the second data set is

selected; determining, based on the authenticating, whether the transaction request is approved;

and completing, if the determining indicates that the transaction request is approved, the

transaction request according to the selection (figs. 1, 4, 6a, and 7 with associated text; c. 3, l. 30-

40; c. 5, l. 27-39; and c. 6, l. 22-67).

8.   Taylor does not directly disclose an RF transaction device; and wherein the first method

of authentication and the second method of authentication each include a distinct access

authentication protocol defined by the first data set owner and the second data set owner,

respectively.

9.   Russell teaches an RF transaction device (¶ 0170).

10.   Since each individual element and its function are shown in the prior art, albeit shown in

separate references, the difference between the claimed subject matter and the prior art rests not

on any individual element or function but in the very combination itself – that is in the

substitution of the RF transaction device of Russell for the transaction device of Taylor. Thus,

the simple substitution of one known element for another, producing predictable results, renders

the claim obvious.

11.   Fisher teaches wherein a first method of authentication and a second method of

authentication each include a distinct access authentication protocol defined by a first data set

owner and a second data set owner, respectively (¶¶ 0039 and 0041; and claim 16).

12.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify the data set owner authentication of Taylor to include the ability

for each data set owner to define a distinct access authentication protocol, as taught by Fisher.

One would have been motivated to do so because each data set owner will require assurance that

any card data used by their specific data set cannot be read or changed by unapproved means

(Fisher, ¶ 0024).

Regarding Claims 3 and 10

13.   The combination of Taylor, Russell, and Fisher discloses the method of claim 1, as

shown above. Taylor, further, discloses wherein at least one of the first secondary identifier

indicium and the second secondary identifier indicium is a personal identifier number (PIN) or a

biometric identifier (Taylor, fig. 7 with associated text); and wherein the receiving a selection

step further comprises receiving an allocation of the entire transaction request to either the first

data set or the second data set (Taylor, fig. 7 with associated text).

Regarding Claims 5, 6, and 11

14.   The combination of Taylor, Russell, and Fisher discloses the method of claim 1, as shown above. Russell, further, discloses wherein the step of receiving a selection further comprises receiving an allocation of a first portion of the transaction request to the first data set for transaction completion (Russell, ¶ 0037); wherein the step of receiving a selection further comprises receiving an allocation of a second portion of the transaction request to the second data set for transaction completion (Russell, ¶ 0037); and wherein the receiving a selection step further comprises receiving a selection of a plurality of data sets to complete the transaction request (Russell, ¶ 0037).

Claim Interpretation

15.   The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris,* 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

    format n. "1. In general, the structure or appearance of a unit of data." <u>Computer Dictionary</u>, 5th Edition, Microsoft Press, Redmond, WA, 2002.

Response to Arguments

16.   Applicants' arguments with respect to the pending claims have been considered but are
moot in view of the new ground of rejection.

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to Applicants'
disclosure (see attached form PTO-892).

18.   Any inquiry of a general nature or relating to the status of this application or concerning
this communication or earlier communications from the Examiner should be directed to Jacob C.
Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on
Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are
unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

19.   Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
applications is available through Private PAIR only. For more information about the PAIR
system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private
PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
December 30, 2009

/ANDREW J. FISCHER/
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